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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,900	01/14/2004	Martin Vorbach	2885/76	4767
7590 08/21/2007				
Michelle M. Carniaux, Esq. KENYON & KENYON One Broadway New York, NY 10004				
			EXAMINER	
			BRITT, CYNTHIA H	
			ART UNIT	PAPER NUMBER
			2117	
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			08/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/757,900

Applicant(s)

VORBACH ET AL.

Examiner

Cynthia Britt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-24 and 26-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-24 and 26-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

Applicant's arguments with respect to the IDS requirements:

"II. Information Disclosure Statement

The Office Action objects to the listing of numerous references in the Information Disclosure Statements (IDS) of May 24, 2004 and November 9, 2006. As an initial matter, Applicants regard all of the listed references as pertinent since they either have been cited in other patent applications filed by one or more of the present Applicants and cross-referenced with the present application, or the references were uncovered during searches by Applicants. For example, the present application cites U.S. Patent Application No. 10/265,846 which is believed to be referenced by, and to reference, still other patent applications filed by the present Applicants.

Further, the Office Action asserts that M.P.E.P. § 2004 requires Applicants to eliminate or otherwise underline some of the references cited in the filed Information Disclosure Statements. The Office Action further states that "the references cited in the IDS of 5/24/04 will not be considered until an *underlining* of the most relevant documents is provided." Office Action, page 2. Applicants respectfully traverse this requirement. M.P.E.P. § 2004 merely provides "suggestions for avoiding duty of disclosure problems"; it does not require compliance with any of the suggestions.

With respect to the Examiner's indication that the references cited in the IDS of May 24, 2004 will not be considered unless Applicants comply with M.P.E.P. § 2004, while Applicants appreciate the Examiner's hesitancy to consider all of the cited references in the IDS, Applicants remind the Examiner that, as set forth in 37 C.F.R. § 1.97 and in M.P.E.P. § 609, "an information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner assigned to the application" and "[o]nce the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, *the examiner has an obligation to consider the information.*" M.P.E.P. § 609 (emphasis added).

III. Requirements

The Office Action provides a laundry list of requirements to which Applicants assertedly must adhere, without providing any basis for the requirements. For example, the Office Action requires Applicants to "[p]rovide how the instant claimed invention is an improvement over each and every reference that is listed in the IDS submission(s)." Office Action, page 3. This requirement appears to impose upon Applicants a requirement normally imposed when filing a petition to make special, which is not applicable in the instant case. Furthermore, M.P.E.P. § 609.04(a)(III) limits the

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instances where an IDS must include a concise explanation of relevance to non-English language information.

Similarly, with respect to the requirements for furnishing copies of literature, the requirements listed in the Office Action appear to require more than specified in M.P.E.P. § 609.04(a)(II).

Accordingly, With respect to each of the requirements A-F listed in the Office Action, Applicants traverse the requirement and request that the Examiner point to a particular rule upon which the Examiner relies as the basis for the requirement. "

The examiner has noted applicants' arguments and this request is being reviewed. If approved, the submitted IDS forms will be initialed and returned prior to any allowance of this application.

Drawings

The drawings were received on 6/5/07. These drawings are acceptable.

Claim Rejections - 35 USC § 112

In response to applicant's remarks with respect to the 35 U.S.C. 112 first paragraph rejection of claims 18-24 and 26-46:

"The Office Action asserts that the claims are not enabled because at least some of the claims do not expressly require testing and "[t]he Specification is almost entirely directed to testing by using algorithms." Office Action, page 6."

"As regards the enablement requirement, the standard for determining whether a patent application complies with the enablement requirement is that the specification describe how to make and use the invention -- which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable.

(See M.P.E.P. § 2164.01 (citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is "whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." (See *id.* (citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988)))."

"The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See *id.* (citing *In re Wands*, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is "improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors," and that the examiner's analysis must therefore "consider all the evidence related to each of these factors" so that any non enablement conclusion "must be based on the evidence as a whole." (See M.P.E.P. § 2164.01). It is respectfully submitted that the Office Action has not addressed these factors."

"It is believed that the present assertions of the Office Action do not meaningfully address -- as they must under the law -- whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the

claims without undue experimentation -- which it plainly does. In short, it is believed that the Office Action's assertion that "[t]he Specification is almost entirely directed to testing by using algorithms," does not address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject matter of the rejected claims -- a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claim."

"It is therefore respectfully submitted that the Office Action has plainly failed to establish that the claim does not comply with the enablement requirement of 35 U.S.C. § 112. Notwithstanding the foregoing, it is respectfully submitted that the claim fully complies with the requirements of 35 U.S.C. § 112 for the following additional reasons."

"The Specification describes and explains how to practice the subject matter in each of the pending claims. For example, with respect to claim 18, the Specification describes running a first program on cells of an integrated circuit, saving data from the cells to a memory in response to a waiting condition, e.g., a wait or IDLE cycle, running a second program on the cells after the data is saved, and subsequently reloading the saved data back into the cells. See Specification, e.g., page 9, lines 14 to 28. While the Specification may refer to a particular example in which the second program is a test program and thereby additionally provide a novel method of testing the cells, nowhere does the Specification indicate that the second program must be a test program. Additionally, the cited section of the Specification refers to the loading of a new program, i.e., even one that is not a test program, before continuation of the program that has reached an IDLE state. In this regard the Specification states that "[n]ew test

data can be loaded until the IDLE cycle is ended by the arrival of new data to be processed, by a new program to be executed or by another request." Specification, e.g., page 9, lines 25 to 28 (emphasis added). Further, one having skill in the art would understand that a program other than a test program may be run as the second program after saving the data of the cells to memory. Similarly, notwithstanding the omission in the other claims of limitations that refer to testing, the Specification similarly enables one skilled in the pertinent art to practice the claimed subject matter of the other pending claims without undue experimentation."

The examiner would like to express that the point that was attempted to be made in the previous office action was that the specification is primarily directed to testing. However, the argument was made by applicant (in order to traverse a restriction requirement) that the claims did not require testing. This was an attempt to clarify the scope of the specification with respect to the claims. Prior to withdrawing this rejection, the examiner would like to request applicant call to set up an interview to clarify this response.

As per applicant's argument with respect to the 35 U.S.C. § 112 second paragraph rejection,:

"To the extent the rejection is based on the Examiner's belief that the claims are overbroad because they may read on numerous types of programs for use as the second program recited in the claims and do not limit the second program to a test program, it is noted that the breadth of a claim is an inappropriate basis for a rejection of the claim. As § 2173.04 of the M.P.E.P., entitled "Breadth Is Not Indefiniteness," states:

"Breadth of a claim is not to be equated with indefiniteness." See also *In re Miller*, 169 USPQ 597 (CCPA 1971). Regardless of breadth, if the scope of the subject matter embraced by the claims is clear, and "[i]f applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph." MPEP § 2173.04. A claim therefore can both be broad and, at the same time, clearly demarcate to those of ordinary skill in the art the boundaries of Applicant's invention. In order to establish that these claims are too broad, that is, that the scope of invention to which Applicants are striving to attain, e.g., without more particularly reciting particular programs for use as the second program, is more than what they are entitled to under the Patent Act, specific evidence in the form of references or other publications must be brought forth by the Patent Office. Therefore, the issue of breadth is one that pertains not to the understandability of the claims, since claims that are broad are not inherently indefinite, but to the outer limits of what Applicants are entitled to exclude others from making, using, or selling, limits which are bounded by what is in the public domain and also by what others have already staked out for themselves as their own property. In other words, the proper rubrics for examining the issue of breadth are those of anticipation and obviousness under §§ 102 and 103. Thus, even if the claims are broad in scope, the claims are, nevertheless, clear, give no rise to ambiguity, and, therefore, definite."

The examiner is uncertain where the issue of breadth came into the rejection. The examiner's rejection does not mention breadth. Again, the examiner invites

applicant to call and set up an interview to clarify these issues prior to responding to this office action.

As such, the previous 35 U.S.C. § 112 rejections will be maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Britt whose telephone number is 571-272-3815. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on 571-272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cynthia Britt
Primary Examiner
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Amendments to the Drawings:

The attached Replacement sheets of drawings for Figs. 1 to 10, and 15 to 19 are submitted in response to the drawing objections as to the inclusion of descriptive labels, as detailed in the Office Action. Approval and entry are respectfully requested, and withdrawal of the objections is respectfully requested.

Attachment: Fourteen (14) Replacement Sheets